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K&L Gates LLP P.O. BOX 1135 CHICAGO, IL 60690			STRANGE, AARON N	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN BORDER, DOUGLAS DILLON, and MATTHEW
BUTEHORN

Appeal 2009-006836
Application 09/996,445¹
Technology Center 2400

Before JAMES D. THOMAS, LANCE LEONARD BARRY, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

C. THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ Application filed November 28, 2001. The real party in interest is Hughes Network Systems, LLC.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1, 3-5, 8, 10-12, 15, 17-19, 22, 24-26, 29, 31-36, and 38, which are all the claims remaining in the application, as claims 2, 6, 7, 9, 13, 14, 16, 20, 21, 23, 27, 28, 30, 37, and 39 are cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

The present invention relates to retrieving web content using proxy servers.

Claim 1 is illustrative:

1. A communication system comprising:
a downstream proxy server configured to communicate with a client that is configured to transmit a message requesting content including an Hypertext Markup Language (HTML) page specifying an object from a content server, wherein the message includes a cookie associated with the client; and
an upstream proxy server configured to include the cookie in a read-ahead request if the cookie is supported by the content server, to retrieve the object, based on the cookie, from the content server and to forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable, over a data network to the downstream proxy server prior to the client transmitting another message requesting the object.

Appellants appeal the following rejection:

1. Claims 1, 3-5, 8, 10-12, 15, 17-19, 22, 24-26, 29, 31-36, and 38 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

ANALYSIS

Our representative claim, claim 1, recites, *inter alia*, “*forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable.*”

Independent claims 8, 15, and 22 recite similar limitations. Thus, the scope of each of the above-noted independent claims includes forwarding based on a time-to-live of the object and the object being marked as uncacheable.

The only rejection/arguments presented relate to the above noted limitation, and no rejection/argument has been presented with respect to independent claim 35, which does not include the above-noted limitation.

Issue: Did the Examiner err in finding that claim 1 is not enabled by the specification?

The Examiner found that “[w]ith regard to claim 1, the limitation ‘forward the object based on a predetermined criteria relating to the object, including time-to-live of the object and the object being marked as uncacheable’ is not enabled by the specification.” (Ans. 3.) The Examiner concluded that “[t]here is simply no reasonable interpretation of ¶41 of the specification where objects with a short time to live, or even a long time to live, are uncacheable.” (Ans. 5.)

Appellants contend that “[t]he language of ¶41 merely discloses that while objects may or may not be cacheable, these objects are less likely to still be fresh. Accordingly, the forwarding of short time-to-live objects is not always inconsistent with the forwarding of uncacheable objects, as the Examiner appears to interpret the disclosure.” (App. Br. 7-8.) Appellants

further contend that “it is clear that ‘while cacheable’ is equivalent to ‘even if these objects can be cached[,]’ [i]t does not mean that all short time to live objects are, *per se*, cacheable.” (App. Br. 8; *see also* Reply Br. 2.) In addition, Appellants contend that “the two criteria are not mutually exclusive, as argued by the Examiner, as an object may be both marked as uncacheable and have only a short time to live.” (App. Br. 9.) We agree with Appellants.

“When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided in the specification of the application.” *In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993). Here, the Examiner concluded that there was “no reasonable interpretation of ¶41 of the specification where objects with a short time to live, or even a long time to live, are uncacheable.” (Ans. 5.) We disagree with the Examiner’s interpretation of Appellants’ Specification. For instance, Appellants’ ¶41 merely discloses that objects which have a short time to live, *while cacheable*, are less likely to be fresh. We interpret this as meaning that objects having a short time-to-live *can be* cached, not that they are necessarily cached each and every time, as interpreted by the Examiner. The Examiner further notes that “a cacheable object would never be marked ‘uncacheable’” (Ans. 3). We disagree again. Appellants’ specification specifically discloses that “the inclusion of a question mark in the URL generally indicates that the object will not be cacheable.” (Spec., ¶38.) In other words, whether an object is cacheable or uncacheable

depends upon whether a question mark is included in the URL. As such, we find that the “time-to live” indicator and the “uncacheable” indicator are not mutually exclusive.

“The enablement requirement is often more indulgent than the written description requirement. The specification need not explicitly teach those in the art to make and use the invention; the requirement is satisfied if, given what they already know, the specification teaches those in the art enough that they can make and use the invention without ‘undue experimentation.’” *Amgen, Inc., v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1334 (Fed. Cir. 2003) (citation omitted). Here, we find that Appellants’ Specification teaches enough about how to forward the object based on a predetermined criteria relating to the object without having those in the art perform undue experimentation.

Therefore, based on the record before us, we find that the Examiner did err in rejecting representative claim 1. Accordingly, we reverse the rejections of claim 1, as well as independent claims 8, 15, and 22, which recite similar limitations. Dependent claims 3-5, 10-12, 17-19, 22, 24-26, 29, and 31-34 also stand with their respective independent claims.

No argument or rejection has been presented with respect to claims 35, 36 and 38, as claims 35, 36, and 38 do not include the limitation noted *supra*. Therefore, we cannot sustain the rejection of claims 35, 36, and 38.

DECISION

We reverse the Examiner’s § 112, first paragraph, rejection of claims 1, 3-5, 8, 10-12, 15, 17-19, 22, 24-26, 29, 31-36, and 38.

Appeal 2009-006836
Application 09/996,445

REVERSED

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